

REMARKS

Claims 1 through 22 are extant in the case. Claims 1 through 22 have been rejected. Applicant has currently amended claims 1, 13 and 22.

Rejection under 35 U.S.C. § 102

Examiner has rejected claim 22 under 35 U.S.C. § 102(b) as being anticipated by USPN 5,353,240 (Mallory). Applicant has amended claim 22. Applicant respectfully traverses the rejection as to claim 22 as amended.

Applicant notes that Examiner's rationale for the rejection under 35 U.S.C. § 102(b) is written as if the claim is rejected under USPN 5,157,782 (Tuttle), not Mallory. Applicant herein responds to the rationale as if claim 22 is rejected under Tuttle.

Criteria for a Rejection under 35 U.S.C. § 102

The criteria for a rejection under 35 U.S.C. § 102(b) has been clearly defined by the courts and confirmed by the U.S. Patent and Trademark Office. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Examiner has failed to show that each and every element set forth in claim 22 is found either expressly or inherently in Tuttle. Based on this, Applicant is traversing the rejection of claim 22.

Below, Applicant clearly and unambiguously points out subject matter within claim 22 that is not disclosed by Tuttle. On the basis of this, Applicant believes claim 22 is patentable over Tuttle.

Discussion of Independent claim 22

Independent claim 22 sets out a system for providing remote testing of a product under test. The system includes a switch that allows an entity separate from the remote user to disconnect the network accessible site from the processing system. This switch is not disclosed by Tuttle.

Examiner has asserted that the processing system is represented by DVPU 124.

Examiner has suggested that a switch that allows an entity separate from a remote user to disconnect a network accessible site from a processing system is disclosed by Tuttle, at column 13, lines 46 through 60. At column 13, lines 46 through 60, Tuttle is describing DVPU 124. In the description at column 13, lines 46 through 60, there is no discussion or suggestion of a switch that allows an entity separate from a remote user to disconnect a network accessible site from DVPU 124. The only discussion of switches in Tuttle at column 13, lines 46 through 60, is the mention of switch settings (see column 13, line 50) that configure the operation of DVPU 124. This is unrelated to the subject matter of

claim 22. Particularly, the switch settings disclosed by Tuttle at column 13, line 50 are apparently internal to DVPU 124 and do not disclose or suggest a switch that allows an entity separate from the remote user to disconnect the network accessible site from a processing system as set out by claim 22 of the present case.

Rejections under 35 U.S.C. § 103

Examiner has rejected claims 1 through 3, 5, 7 through 15, and 17 under 35 U.S.C. § 103(a), as being anticipated by USPN 5,157,782 (Tuttle) in view of USPN 5,353,240 (Mallory) and USPN 6,360,268 B1 (Silva). Examiner has rejected claims 4, 18, 19 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Tuttle in view of USPN 6,115,645 (Berar). Examiner has rejected claims 6, 16 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Tuttle in view of USPN 6,094,720 (Cromer).

Criteria for a Rejection under 35 U.S.C. § 103(a)

The U.S. Patent and Trademark Office has set forth a methodology for establishing a *prima facie* case of obviousness. Specifically three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

See MPEP 706.02 (j).

Applicants believes the Examiner has failed to establish a *prima facie* case of obviousness for the claims extant in the present case because there are claim limitations that are not taught or suggested by any of the cited references.

Below, Applicants clearly and unambiguously points out subject matter within each independent claim that is not disclosed or suggested by any of the cited references. At least on the basis of this, Applicants believes all the claims are patentable over the cited references.

Independent claim 1

Independent claim 1 sets out a system for providing remote testing of a product under test. The system comprises a network accessible site, a processing system and a test controller. The test controller directly introduces to the product under test hardware commands that are not covered in software control. This is not disclosed by the cited references.

Examiner has suggested that Mallory teaches an apparatus for testing computer systems that initiates hardware commands to a product under test by a test controller. This is an misleading description of Mallory.

Mallory discloses that a power cord 102 is connected from a unit under test 100 to an automated power cycler 103 (See Figure 1). Because power cycler 103 is connected to power cord 102, power cycler 103 is able to interrupt and restore power to unit under test 100. Thus, Mallory is not able to give hardware commands to unit under test 100. Mallory can only interrupt and restore power to unit under test 100 via a power cord to unit under test 100.

Interrupting and restoring power to a unit under test via a power cord does not disclose or suggest the test controller in claim 1 that is able to directly introduce to the product under test hardware commands that are not covered in software control.

The ability to directly introduce during remote test of a product, hardware commands that are not covered in software control is a significant improvement not disclosed or suggested by prior art systems. These hardware commands, such as power-on and reset, are referred to as hardware commands because they have to do with switching on power to hardware, and/or performing a hardware reset. See Applicants' Specification at page 4 line 35 through page 5, line 2. This functionality is different than merely interrupting and restoring power to a unit under test via a power cord, as shown by Mallory.

Response to Examiner's New Arguments

Examiner has cited Mallory at column 2, lines 22 through 49 and argued that Mallory clearly teaches a device that presents inputs to a product under test directly and presents commands not covered in software control.

However, this is not an accurate description of what Mallory discloses at column 2, lines 22 through 49. Rather, Mallory includes a switch circuit capable of interrupting and restoring power to the computing equipment. See column 2, lines 35 through 38. The computing equipment, if working properly, will reset when power is cut off and then restored. See column 2, lines 44 through 46.

Interrupting and restoring power to computing equipment is not the same as directly introducing to a product under test, hardware commands that are not covered in software control. While one might argue that interrupting and restoring power is one way to indirectly cause a reset in the computing equipment of Mallory, it is clear that no one reading claim 1 would mistakenly assume that what is meant by *directly* introducing hardware commands to a product under test is the same thing as interrupting and restoring a power supply.

Interrupting and restoring a power supply are merely acts affecting power delivered to a computing system. No one of skill in the art would mistake this for *directly* introducing hardware commands to a product under test as is set out in claim 1 of the present case.

Independent claim 13

Independent claim 13 sets out a system for providing remote testing of a plurality of products under test. The system includes a processing system for receiving first input for any one of the plurality of products under test from the network accessible site and presenting the first input to the one of the products under test as if the first input came from an input device directly connected to the one of the products under test. The processing system is configured to present directly to the one of the plurality of products under test a hardware command. This is not disclosed or suggested by the combination of the cited references.

As discussed above, Examiner has suggested that Mallory teaches an apparatus for testing computer systems that initiates hardware commands to a product under test by a test controller. This is an inaccurate description of Mallory.

Mallory does not disclose or suggest an apparatus for testing computer systems that initiates hardware commands to a product under test. Rather, Mallory only discloses that a power cord 102 is connected from a unit under test 100 to an automated power cycler 103 (See Figure 1). Because power cycler 103 is connected to power cord 102, power cycler 103 is able to interrupt and restore power to unit under test 100. Thus, Mallory is not able to give hardware commands to unit under test 100. Mallory can only interrupt and restore power to unit under test 100 via a power cord to unit under test 100.

Interrupting and restoring power to a unit under test does not disclose or suggest the processing system, set out in claim 13, that is able to present a hardware command directly to the one of the plurality of products under test.

The ability to introduce during remote test of a product, hardware commands that are not covered in software control is a significant improvement not disclosed or suggested by prior art systems such as Mallory. These hardware commands, such as power-on and reset, are referred to as hardware commands because they have to do with switching on power to hardware, and/or performing a hardware reset. See Applicants' Specification at page 4 line 35 through page 5, line 2. This functionality is different than merely

interrupting and restoring power to a unit under test via a power cord, as shown by Mallory.

Response to Examiner's New Arguments

Examiner has cited Mallory at column 2, lines 22 through 49 and argued that Mallory clearly teaches a device that presents inputs to a product under test directly and presents commands not covered in software control.

However, this is not an accurate description of what Mallory discloses at column 2, lines 22 through 49. Rather, Mallory includes a switch circuit capable of interrupting and restoring power to the computing equipment. See column 2, lines 35 through 38. The computing equipment, if working properly, will reset when power is cut off and then restored. See column 2, lines 44 through 46.

Interrupting and restoring power to computing equipment is not the same as presenting a hardware command directly to the one of the plurality of products under test. While one might argue that interrupting and restoring power is one way to indirectly cause a reset in the computing equipment of Mallory, it is clear that no one reading claim 13 would mistakenly assume that what is meant by presenting a hardware command directly to the one of the plurality of products under test is the same as interrupting and restoring a power supply.

Interrupting and restoring a power supply are merely acts affecting power delivered to a computing system. No one of skill in the art would

mistake this for presenting a hardware command directly to the one of the plurality of products under test as is set out in claim 13 of the present case.

Independent claim 18

Independent claim 18 sets out a method for providing remote testing of a product under test. In claim 18, display information from the product under test is obtained using a web camera. The display information describes a current display generated by the product under test. This is not disclosed or suggested by the combination of Tuttle and Berar.

Examiner has argued that Berar teaches a semiconductor testing apparatus that uses a camera to acquire images of a product under test and transfers this data to a network accessible site. However, Berar does not disclose or suggest the pertinent subject matter set out in claim 18.

Specifically, claim 18 sets out that display information from the product under test is obtained using a web camera. *The display information describes a current display generated by the product under test.*

Thus, as set out by claim 18, the product under test generates a display. The display generated by the product under test is what is obtained by the web camera. This is significantly different from what is disclosed by Berar.

First, in Berar, the integrated circuits being tested do not produce a display, so there is no “display generated by a product under test” to be obtained.

Second, in Berar, the video camera acquires images *not* of the device under test, but rather of the device handler (which is part of the semiconductor tester the product under test). See column 3, lines 19 through 22.

So it is clear Berar does not disclose or suggest that display information from a product under test is obtained using a web camera as set out in claim 18. Berar does not disclose any information from a product under test being obtained by a video camera (but only images of a handler that is part of test equipment). Further Berar does not disclose or suggest obtaining display information that describes a current display generated by the product under test, as set out in claim 18. Berar does not obtain information about a current display generated by a product under test (or any other entity), but only takes pictures of physical objects, i.e., a handler that is part of semiconductor test equipment.

Response to Examiner's New Arguments

Examiner has stated that an intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art.

Examiner appears to be confusing the method step "obtaining display information from the product under test using a web camera, the display information describing a current display generated by the product under test" with the intended use of the method.

The “intended use”, if present in a claim, is typically found as introductory words in a preamble. The intended use for the method set out in claim 18 is for providing remote testing of a product under test.

The recited method step “obtaining display information from the product under test using a web camera, the display information describing a current display generated by the product under test” is not the intended use of the method. This method step indicates that in order to accomplish the method, display information is obtained from the product under test using a web camera. The display information describes a current display generated by the product under test. This method step is not an intended use, but rather a claim limitation of claim 18.

Independent claim 19

Likewise independent claim 19 sets out a system for providing remote testing of a product under test. The system includes a display entity for receiving and displaying intercepted display information. The display information describes a current display generated by the product under test. The display information is obtained using a web camera. This is not disclosed or suggested by the combination of Tuttle and Berar.

As discussed above, Examiner has argued that Berar teaches a semiconductor testing apparatus that uses a camera to acquire images of a product under test and transfers this data to a network accessible site. However,

Berar does not disclose or suggest the pertinent subject matter set out in claim 19.

In Berar, the integrated circuits being tested do not produce a display, so there is no display generated by a product under test to be obtained.

In Berar, the video camera acquires images *not* of the device under test, but rather of the device handler (which is part of the semiconductor tester the product under test). See column 3, lines 19 through 22.

So it is clear Berar does not disclose or suggest a display entity for receiving and displaying intercepted display information where the display information describes a current display generated by the product under test.

Response to Examiner's New Arguments

Examiner has stated that an intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art.

Examiner appears to be confusing the method step "obtaining display information from the product under test using a web camera, the display information describing a current display generated by the product under test" with the intended use of the method.

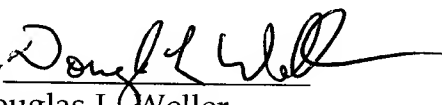
The "intended use", if present in a claim, is typically found as introductory words in a preamble. The intended use for the method set out in claim 19 is for providing remote testing of a product under test.

The recited method step "obtaining display information from the product under test using a web camera, the display information describing a current display generated by the product under test" is not the intended use of the method. This method step indicates that in order to accomplish the method, display information is obtained from the product under test using a web camera. The display information describes a current display generated by the product under test. This method step is not an intended use, but rather a claim limitation of claim 19.

Conclusion

Applicant believes that this Amendment has placed the present case in condition for allowance and favorable action is respectfully requested.

Respectfully submitted,
MARY J. HORNBERGER, ET AL.

By 
Douglas L. Weller
Reg. No. 30,506

February 23, 2004
Santa Clara, California
(408) 985-0642